

REMARKS

Claims 1, 5-11, 14-16, and 19-21 are pending in this application. None have been allowed. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

At paragraph 1 of the Action, the Examiner has made final applicants election of Group I, claims 1-16 and 19-21. At paragraph 2 of the Action, the Examiner has withdrawn claims 17-18 and 22-31.

In response, Applicants have cancelled claims 17-18 and 22-31.

At paragraph 3 of the Action, the Examiner indicates that Claims 3-4 and 12-13 are also withdrawn from consideration, as they are drawn to non-elected species. Applicants infer from the Examiner's statement that compounds not bearing a hetero ring at R3 are non-elected subject matter. The Examiner also states that: Claims 11-12 also refer to the R4 substituent as being selected from groups that do not include methyl: the R4 substituent for the elected species is methyl." (Emphasis added)

Applicants wish to point out that the species elected had R4 = Chloro. The Examiner included methyl. Applicants seek guidance from the Examiner as to the breadth of R4 that falls within the Group elected by applicants.

At paragraph 10 of the Action, the Examiner rejects Claims 1-2, 5-11, 14-15 and 19-21 as obvious under 35 USC 103(a) over US 5,693,809, in view of US 6,416,737. Regarding '809, the Examiner argues that '809 discloses reference compound 7 at column 259, Table 7. This compound corresponds to applicants' formula I where:

R1 = CH₃,

R2 = H,

R3 = (pyridine-4-yl),

R4 = H,*

X = H,

Y = H,

a = a single bond, and

b = a single bond.

[* Applicants note that in their genus of formula I, R4 cannot be hydrogen.]

The Examiner argues further that the only difference between compound 7 and applicants genus of compounds is that the reference compound bears R4 = hydrogen, whereas applicants genus has "R4 = CH3". The Examiner concludes that applicants' claims are obvious over compound 7, based on the view that methyl and hydrogen are considered homologues.

Applicants respectfully traverse. As is well appreciated the "homologue" argument has validity only when it is predictable that both homologues will have substantially the same activity. As stated in MPEP 2144.09: "Rejection based on close structural similarity is founded on the expectation that compounds similar in structure will have similar properties." Applicants respectfully submit that there is no such expectation for applicants steroids. To illustrate the point, applicants respectfully submit a reference by Rasmusson. In particular, applicants direct the Examiner's attention to Table IV at page 2304. As shown, depending on the substituent pattern, replacement of a hydrogen with a methyl can, and often does make a vast difference in properties. While applicant acknowledge that the reference discusses steroids that are far different than those at issue here, applicants respectfully the reference is more than sufficient to rebut the sweeping generalization relied upon by the Examiner. Accordingly, applicants respectfully submit that the Examiner must withdraw the rejection.

At the bottom of page 8 of the Action, the Examiner directs Applicants to a reference identified only as "US '514". The reference is not listed in the list of references

attached to the office Action. Moreover, while the Examiner mentions "US 6,416,737", given that '737 reference does not have the required number of columns, '737 cannot have been intended. Should the Examiner continue to believe this reference is relevant, the Examiner must send out a new, non-final Action.

Applicants nonetheless, take this opportunity, to point out the Examiner's present argument does not logically follow from the facts. As applicants have shown above, the Examiner has no basis for the conclusion that applicants compounds must be 5 α reductase inhibitors.

At paragraph 13 of the Action, the Examiner rejects claims 1-2 and 5-8 on the ground of obviousness type double patenting over US 7,482,357. In addition, at paragraph 16 of the Action, the Examiner provisionally rejects claims 1-2 and 5-8 on the ground of obviousness type double patenting over claims 1, 7 and 9-11 of US 10/557229.

Once again, applicants direct the Examiner's attention to Rasmusson, and respectfully sub that there is no basis for arguing that in the present class of compounds, replacement of a hydrogen with a methyl is expected to result in a compound with similar properties. Accordingly, applicants traverse.

At paragraph 18, the Examiner objects to claim 16 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicants have amended the claims as indicated.

At paragraph 19, the Examiner objects to claim 21 as being dependent on itself. The Examiner presumes that the claim was intended to depend from claim 19, and required appropriate correction. In response, Applicants have amended the claim to depend on claim 20.

Having addressed the outstanding issues, Applicants respectfully request early examination and allowance of the claims. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of this application.

Respectfully submitted,

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